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7 UNITED STATES DISTRICT COURT  
8 WESTERN DISTRICT OF WASHINGTON  
9 AT SEATTLE

10 SUR LA TABLE, INC.,

11 Plaintiff,

12 v.

13 SAMBONET PADERNO  
14 INDUSTRIE, S.p.A., ROSENTHAL  
15 SAMBONET USA, LTD., d/b/a  
PADERNO WORLD CUISINE and  
WORLD CUISINE,

16 Defendants.

CASE NO. C14-1742JLR

ORDER

17 **I. INTRODUCTION**

18 Before the court is Defendants Sambonet Paderno Industrie S.p.A. and Rosenthal  
19 Sambonet USA, Ltd., d/b/a/ Paderno World Cuisine and World Cuisine's (collectively  
20 "Sambonet") motion to dismiss Plaintiff Sur La Table, Inc.'s ("Sur La Table") complaint.  
21 (Mot. (Dkt. # 9).) Approximately one month after Sur La Table filed its complaint in this  
22 case, Sambonet filed an action in the Central District of California that is, for all practical

1 purposes, the mirror image of this one. Sambonet argues that this action is an improper  
2 anticipatory suit, and therefore, Sambonet asks this court to dismiss Sur La Table's  
3 action. The court has considered the motion, all submissions filed in support of and  
4 opposition to the motion, the balance of the record, and the applicable law. No party has  
5 asked for oral argument, and the court deems this motion appropriate for disposition  
6 without it. For the reasons stated below, the court GRANTS Sambonet's motion to  
7 dismiss.

## 8 **II. BACKGROUND**

9 Plaintiff, Sur La Table, is a company based in Seattle, Washington, that sells  
10 gourmet kitchen, food, and related products. (*See* Compl. (Dkt. # 1) at 2.) Sambonet also  
11 manufactures and sells a variety of kitchen products, including a "Spiral Vegetable  
12 Splicer." (Perry Decl. (Dkt. # 10) Ex. A at 1). On October 28, 2014, an attorney  
13 representing Sambonet sent a letter to Sur La Table via e-mail accusing Sur La Table of  
14 selling a "flagrant counterfeit copy" of Sambonet's Spiral Vegetable Slicer product and  
15 thereby infringing on Sambonet's protected trade dress. (*Id.* at 2.) In the letter,  
16 Sambonet demanded that Sur La Table "immediately cease and desist" all sales and  
17 advertisements of the allegedly infringing product. (*Id.* at 3.) The following day,  
18 October 29, 2014, Sambonet's attorney sent Sur La Table another letter in which he  
19 clarified that unless Sur La Table responded to the cease-and-desist letter "within ten (10)  
20 days" or otherwise resolved the issue, Sambonet would "file a lawsuit for trade dress  
21 infringement and other related claims in the United States District Court for the Central  
22 District of California." (Perry Decl. Ex. B at 2.)

1 One week later, on November 5, 2014, Sur La Table's attorney responded in a  
2 letter sent to Sambonet's attorney via e-mail. (Perry Decl. Ex. C.) Sur La Table's  
3 attorney acknowledged receipt of the letters dated October 28 and 29, 2014, and informed  
4 Sambonet's attorney that the matter had been referred to him "for investigation." (*Id.* at  
5 2.) On November 12, 2014, Sur La Table filed suit in this court, requesting a declaratory  
6 judgment of non-infringement with respect to Sambonet's claims of trade dress  
7 infringement. (Compl. at 2.)

8 The following day, November 13, 2014, Sur La Table's attorney sent a copy of the  
9 complaint to Sambonet's attorney, via email, to notify him of the present suit. (Perry  
10 Decl. Ex. D.). The cover letter explained that Sur La Table had no intention of halting  
11 sales of the allegedly infringing product, but that it would "consider any proposal" for  
12 alternative resolution of the dispute. (*Id.* at 3.) Besides the introductory letter sent  
13 November 5, 2014, Sur La Table's attorneys did not make any other attempt to contact  
14 Sambonet's counsel to discuss the matter prior filing suit in this court. (Perry Decl. ¶ 6.)

15 On December 10, 2014, Sambonet filed an action against Sur La Table in the  
16 Central District of California. *See Sambonet Paderno Industrie, S.P.A. v. Sur La Table,*  
17 *Inc.*, No. 2:14-cv-09473-FMO-RZ (C.D. Cal. Dec. 10, 2014). In that action, Sambonet  
18 alleges the same trade dress claims at issue in this action, along with other violations of  
19 California law. On December 12, 2014, Sambonet's counsel sent a letter to Sur La  
20 Table's attorneys demanding that Sur La Table dismiss the action filed in this court.  
21 (Perry Decl. Ex. F at 2.) When counsel for Sur La Table refused, (Perry Decl. ¶¶ 11-12.),  
22 Sambonet filed this motion to dismiss (*see generally* Mot.).

### III. ANALYSIS

The Supreme Court has explained that, “[i]n the declaratory judgment context, the normal principle that federal courts should adjudicate claims within their jurisdiction yields to considerations of practicality and wise judicial administration.” *Wilton v. Seven Falls Co.*, 515 U.S. 277, 288 (1995). When deciding whether to exercise jurisdiction over a declaratory judgment action, courts “must balance concerns of judicial administration, comity, and fairness to litigants.” *Principal Life Ins. Co. v. Robinson*, 394 F.3d 665, 672 (9th Cir. 2005) (quoting *Am. States Ins. Co. v. Kearns*, 15 F.3d 143, 144 (9th Cir. 1994)). One doctrine that often applies in instances such as this is the so-called first-to-file rule. *See Alltrade, Inc. v. Uniweld Products, Inc.*, 946 F.2d 622, 628 (9th Cir. 1991).

Under the first-to-file rule, a district court may transfer, stay, or dismiss an action when a suit involving similar parties and issues has been filed in another district. *Alltrade*, 946 F.2d at 623; *Pacesetter Sys., Inc. v. Medtronic, Inc.*, 678 F.2d 93, 94-95 (9th Cir. 1982). Although the rule should not be disregarded lightly, “district court judges can, in the exercise of their discretion, dispense with the first-filed principle for reasons of equity.” *Alltrade*, 946 F.2d at 628. When determining whether application of the first-to-file rule is appropriate, courts generally evaluate three threshold factors: (1) the chronology of the two actions, (2) the similarity of the parties, and (3) the similarity of the issues. *Id.* at 625. As the Ninth Circuit explained in *Alltrade*, “[t]he circumstances under which an exception to the first-to-file rule typically will be made include bad

1 faith, . . . anticipatory suit, and forum shopping.” *Alltrade*, 946 F.2d at 628 (citations  
2 omitted).

3       There is no dispute that the Washington action was filed before the California  
4 action, and that the two actions involve the same parties and substantially similar issues.  
5 Thus, the question of whether the first-to-file rule applies turns on whether the  
6 Washington action was anticipatory. As this court has previously explained, “[a]n action  
7 is anticipatory when the plaintiff files it after receiving ‘specific, concrete indications that  
8 a suit by the defendant was imminent.’” *ivi, Inc. v. Fisher Commc’ns*, No. C10-1512JLR,  
9 2011 WL 197419, at \*3 (W.D. Wash. Jan. 19, 2011) (quoting *Guthy-Renker Fitness, LLC*  
10 *v. ICON Health & Fitness, Inc.*, 179 F.R.D. 264, 271 (C.D. Cal. 1998)). “Application of  
11 the first to file rule in such situations would thwart settlement negotiations, encouraging  
12 intellectual property holders to file suit rather than communicate with the alleged  
13 infringer.” *Z-Line Designs, Inc. v. Bell’O Int’l LLC*, 218 F.R.D. 663, 665 (N.D. Cal.  
14 2003).

15       It is true that the timing of a lawsuit, by itself, cannot make a suit anticipatory; if it  
16 could, then “nearly every declaratory judgment action would be anticipatory.”  
17 *Volunteers for Catholic Orgs. v. Superior Council of the U.S.*, No. C13-00281 PSG, 2013  
18 WL 4533782, at \*1 (N.D. Cal. Aug. 26, 2013). This court has explained, however, that  
19 when “a declaratory judgment action has been triggered by a cease and desist letter,  
20 equity militates in favor of allowing the second-filed action brought by the true plaintiff  
21 in the dispute to proceed to judgment rather than the first.” *ivi, Inc.*, 2011 WL 197419, at  
22 \*3. Other decisions in this circuit support the same conclusion. *See, e.g., Topics Entm’t*

1 *Inc v. Rosetta Stone Ltd.*, No. C09-1408RSL, 2010 WL 55900, at \*4 (W.D. Wash. Jan.  
 2 10, 2010); *K-Swiss, Inc. v. Puma AG Rudolf Dassler Sport*, No. CV 09-3022 GAF  
 3 (PLAx), 2009 WL 2049702, at \*3 (C.D. Cal. July 9, 2009); *Xoxide, Inc. v. Ford Motor*  
 4 *Co.*, 448 F. Supp. 2d 1188, 1193 (C.D. Cal. 2006); *Z-Line*, 218 F.R.D. at 667.

5 This dispute was triggered when Sur La Table received two letters from  
 6 Sambonet, on October 28 and 29, 2014. The first letter explicitly demanded that Sur La  
 7 Table “immediately cease and desist” the allegedly infringing activity and respond within  
 8 10 business days. (Perry Decl. Ex. A at 3.) The second letter clarified that Sambonet  
 9 was prepared to file suit in the United States District Court for the Central District of  
 10 California if Sur La Table failed to respond or otherwise resolve the issues Sambonet had  
 11 raised “within ten (10) days from the date the [first letter] was sent.” (Perry Decl. Ex. B  
 12 at 2.) Sur La Table’s attorney replied one week later, on November 5, 2014, with an  
 13 introductory letter sent via email in which he explained that the matter had been referred  
 14 to him “for investigation.” (Perry Decl. Ex. C at 1.) Before communicating with  
 15 Sambonet’s attorney again, however (Perry Decl. ¶ 6), Sur La Table filed this action on  
 16 November 12, 2014—a mere seven days after its attorney sent the introductory letter.

17 On November 13, 2014—the day after this action was filed—Sur La Table’s  
 18 attorney sent a copy of the complaint to Sambonet’s attorney via e-mail, and, in the cover  
 19 letter, expressed Sur La Table’s belief that Sambonet’s trade dress claims were “without  
 20 merit.” (Resp. (Dkt. # 12) at 4; Perry Decl. Ex. D.) The cover letter also stated that Sur  
 21 La Table had no intention of discontinuing sales of the disputed product, but that it would  
 22 be “willing to consider other ways to resolve this dispute.” (*Id.*)

1 To support this questionable behavior, Sur La Table contends that Sambonet  
2 effectively forced Sur La Table to file this suit when Sambonet failed to file its own  
3 action when the 10-day “deadline set by Sambonet came and went without any filing by  
4 Sambonet.” (Resp. at 4.) Sur La Table points out that Sambonet did not, in fact, file suit  
5 in California until December 10, 2014, “nearly one month after Sur La Table filed this  
6 action and more than one month after Sambonet’s initial ‘threat’ of litigation deadline  
7 passed.” (*Id.* at 5.) Instead of communicating with Sambonet to discuss the dispute prior  
8 to filing, however, Sur La Table jumped to the conclusion that a non-judicial “resolution  
9 of the dispute was impossible,” because “no settlement short of complete cessation of  
10 sales was even hinted at by Sambonet” in its letters dated October 28 and 29, 2014. (*Id.*  
11 at 8.) Sur La Table attempts to bolster its claims that this action should proceed here by  
12 explaining that “all of Sur La Table’s witnesses and evidence are in Seattle” (*id.* at 2),  
13 while speculating that “Sambonet’s witnesses and evidence are likely spread throughout  
14 the United States and Italy.” (*Id.* at 3).

15 Sambonet argues that this suit is anticipatory—and therefore improper—because  
16 Sur La Table knew “it was about to be sued by Sambonet for trade dress infringement  
17 based on the identical facts alleged here.” (Mot. at 5.) Sambonet asserts that it did not  
18 file its suit by the initial deadline it had set because “[t]hat date certain was obviated by  
19 [Sur La Table] counsel’s deceptive letter stating he was investigating the facts.” (Reply  
20 (Dkt. # 15) at 8.) Permitting this suit to proceed would, according to Sambonet, “thwart  
21 the important public policy that encourages intellectual property holders . . . to attempt to  
22 settle their disputes without the need for court intervention.” (Mot. at 5.) Additionally,

1 as the “natural plaintiff,” Sambonet contends that choice of forum belongs to it (*id.*), and  
 2 that Sur La Table’s focus on convenience factors “sidesteps” the primary issue: Whether  
 3 Sur La Table’s action was an improper anticipatory declaratory relief suit (Reply at 1-2).  
 4 In any event, Sambonet asserts that the Central District of California is the most  
 5 convenient forum for this dispute because most of its witnesses, its development and  
 6 sales of the product at issue, and its efforts to restrain the product’s counterfeiting are  
 7 centered in Los Angeles, California. (*Id.* at 9.)<sup>1</sup>

8 The court largely agrees with Sambonet. Sambonet’s cease-and-desist letters  
 9 constitute “specific, concrete indications that a suit by the defendant was imminent.” *ivi*,  
 10 *Inc.*, 2011WL 197419, at \*3. Sur La Table’s rush to file the action here, before even  
 11 attempting to discuss a possible resolution with Sambonet, makes this action an improper  
 12 anticipatory suit. The totality of the circumstances here leads the court to conclude that  
 13 an exception from the ordinary first-to-file rule applies. Although the court notes the  
 14 importance of generally adhering to the first-to-file rule, in this case, it exercises its  
 15 discretion to decline to hear Sur La Table’s case.<sup>2</sup> *Alltrade*, 946 F.2d at 628.

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17 <sup>1</sup>Nothing in the court’s decision precludes Sur La Table from petitioning the district court  
 18 in the Central District of California to transfer the case to this district under 28 U.S.C. § 1404.

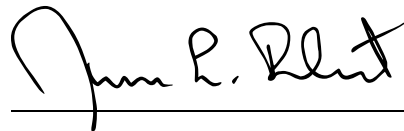
19 <sup>2</sup>In its reply memorandum, Sambonet asserts that Sur La Table’s responsive  
 20 memorandum was filed four days late, and therefore the court should strike it. (Reply at 9-10.)  
 21 Sambonet’s motion was noted for Friday, January 23, 2015. (*See* Mot. at 1.) Therefore, Sur La  
 22 Table’s response ordinarily would have been due on Monday, January 19, 2015. *See* Local  
 Rules W.D. Wash. LCR7(b)(3) (“Any opposition papers shall be filed and served not later than  
 the Monday before the noting date.”). However, “[i]f the deadline for a party’s response . . . falls  
 on a date that is a legal holiday . . . , the party’s response . . . is due on the following day that is  
 not a Saturday, Sunday, or legal holiday.” *Id.* LCR 7(d)(5). Monday, January 19, 2015, was a  
 legal holiday. Accordingly, Sambonet’s response, which was filed the next day, was timely.



**IV. CONCLUSION**

For the foregoing stated reasons, the court GRANTS Sambonet's motion to dismiss (Dkt. # 9), and DISMISSES this matter without prejudice to Sur La Table's rights to seek any appropriate claims or other relief in the Central District of California lawsuit.

Dated this 27th day of March, 2015.

A handwritten signature in black ink, appearing to read "James L. Robart", written over a horizontal line.

JAMES L. ROBART  
United States District Judge

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On January 26, 2015, Sur La Table filed a surreply in which it moved the court to strike the second declaration of Michael Perry (2d Perry Decl. (Dkt. # 16)), which was filed in conjunction with Sambonet's reply memorandum. (Surreply (Dkt. # 19) at 2-3.) The court did not consider Mr. Perry's second declaration in granting Sambonet's motion to dismiss, and accordingly DENIES Sur La Table's motion to strike as moot.